

REMARKS

Summary of the Office Action

Claims 1-3 and 10-22 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Sato (U.S. Patent No. 6,914,691).

Claim 4 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Sato.

Claim 5 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Sato in view of Microsoft Windows NT/95/98.

Claims 6-8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sato in view of Kadowaki (U.S. Patent No. 6,813,038).

Claim 9 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Sato in view of Shah (U.S. Patent Pub. No. US20020085756).

Summary of the Response to the Office Action

Applicants have amended claims 1, 2, 19, 21 and 22. Applicants have also added claim 23 to further define the invention. Accordingly, claims 1-23 are presently pending.

In addition, Applicants submit concurrently herewith a verified translation of Japanese Patent Application No. 2000-127995.

The Rejection of claims 1-8 and 10-22

Claims 1-3 and 10-22 stand rejected under 35 U.S.C. §102(e) as being anticipated by Sato (U.S. Patent No. 6,914,691). Claim 4 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Sato. Claim 5 stands rejected under 35 U.S.C. § 103(a) as being unpatentable

over Sato in view of Microsoft Windows NT/95/98. Claims 6-8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sato in view of Kadowaki (U.S. Patent No. 6,813,038).

Applicants respectfully traverse the rejection at least for the following reasons.

With respect to independent claim 1, as amended, Applicants respectfully submit that Sato fails to teach or suggest a combination comprising a determination unit and a recognition unit. The Office Action suggests that column 7, lines 19-23, of Sato discloses a “determination unit” as claimed and that column 7, lines 27-34, of Sato discloses a “recognition unit” as claimed. Applicants respectfully disagree. Here, both cited portions of Sato refer to the system (i.e., the print controller 102 of Sato). Thus, Applicants respectfully assert that Sato only discloses one “unit” and lacks any teaching of separate “units” as claimed. Accordingly, Applicants respectfully submit that Sato would suffer from problems similar to those of the related art discussed at pages 1-3 of the present application.

Accordingly, Applicants respectfully assert that independent claim 1, as amended, is allowable. Moreover, Applicants respectfully submit that independent claims 2 and 19-22, as amended, are allowable for reasons similar to those of independent claim 1, as amended.

Applicants respectfully assert that the rejection of independent claims 1-2 and 19-22 under 35 U.S.C. §102 should be withdrawn because Sato fails to teach or suggest each feature of independent claims 1-2 and 19-22, as amended. As pointed out in MPEP § 2131, “[t]o anticipate a claim, the reference must teach every element of the claim.” Thus, “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of California, 2

USPQ 2d 1051, 1053 (Fed. Cir. 1987).” Similarly, as pointed out in MPEP § 2143.03, “[t]o establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 409 F.2d 981, 180 USPQ 580 (CCPA 1974).”

Furthermore, Applicants respectfully assert that dependent claims 3-8 and 10-18 are allowable at least because of their respective dependencies from independent claims 1 and 2, as amended, and the reasons set forth above.

Claim 9

Claim 9 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Sato in view of Shah (U.S. Patent Pub. No. US20020085756). Applicants respectfully traverse the rejection at least for the following reasons.

With respect to independent claim 9, Applicants respectfully submit that Shah (U.S. Patent Pub. No. US20020085756) should be removed as prior art in the present application under any subsection of 35 U.S.C. §§ 102 or 103. Pursuant to 37 C.F.R. § 1.55(a), Applicants submit concurrently herewith a verified translation of Japanese Patent Application No. 2000-127995.

The U.S. filing date of Shah is December 28, 2000 which is after the priority date to which this application is entitled. The publication date of any foreign counterpart applications of Shah would also presumably be after the priority date to which this application is entitled.

Accordingly, Applicants respectfully submit that Shah should be removed as prior art in the present application under any subsection of 35 U.S.C. §§ 102 or 103.

Conclusion

In view of the foregoing, Applicants respectfully request reconsideration and the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact the Applicants' undersigned representative to expedite prosecution.

If there are any other fees due in connection with the filing of this paper, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully Submitted,

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